

AMENDMENT AFTER NON-FINAL ACTION

Appln. No. 10/606,498

Docket No. 442005-00105

**REMARKS**

Claims 1, 4-8, 10-13, 16-17, 19-24, and 26 are pending in the application. Claims 1, 5-8, and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,729,949 to Hartzheim ("Hartzheim '949") in view of U.S. Patent No. 3,582,029 to Moesta ("Moesta '029"). Claims 4 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hartzheim '949 in view of Moesta '029 and further in view of U.S. Patent No. 3,682,422 to Evans ("Evans '422"). Claims 10-13, 17, 20-24, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hartzheim '949 in view of Moesta '029 and further in view of U.S. Patent No. 6,089,522 to Haslem et al. ("Haslem '522").

*Rejection of all pending claims over Hartzheim '949 in view of Moesta '029*

Claims 1, 5-8, and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hartzheim '949 in view of Moesta '029. Claims 4, 10-13, 17, 20-24, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hartzheim '949 in view of Moesta '029 and other additional references. All of the rejected claims require a chair "wherein each notch comprises a bearing surface defined by a lip extending inwardly from the outer surface such that the bearing surface is cantilevered beyond the inner surface." The Office admits that Hartzheim '949 does not disclose the claimed structure. However, the Office alleges that Moesta '029 discloses "the bearing surface of each notch defined by a lip (16) extending inwardly beyond the inner surface to provide for extra supporting surface for the tubular member (6)," and argues that it would have been obvious to modify the device of Hartzheim '949 "because it would provide more supporting surface for a tubular structure as taught by Moesta." Office Action mailed 12/21/2006 at p. 3.

We respectfully argue that the Office's rejection under 35 U.S.C. § 103(a) is both incomplete and improper, and therefore must be withdrawn. Office policy is to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. § 103. In the absence of evidence concerning secondary considerations, three factual inquiries are

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necessary for the consideration and determination of obviousness:

- (A) Determining of the scope and content of the prior art;
- (B) Ascertaining the differences between the prior art and the claimed invention; and
- (C) Resolving the level of ordinary skill in the pertinent art.

MPEP § 2141. With respect to the first inquiry, "[i]n order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." MPEP § 2141.01(a); *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992). With respect to the second inquiry, the question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. MPEP § 2141.02 (emphasis added); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782 (Fed. Cir. 1983). Moreover, the references must be considered in their entirety, including portions that would lead away from the claimed invention. MPEP § 2141.02 (emphasis added); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983).

The Office bears the initial burden of factually supporting a *prima facie* conclusion of obviousness. MPEP § 2142. Impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of facts gleaned from the prior art. *Id.* Moreover, the teaching or suggestion to make the claimed combination must be found in the prior art, and not in the Applicants' disclosure. MPEP § 2143; *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). With respect to findings in a determination of patentability, the Office cannot reach conclusions based on its own understanding or experience, rather, the Office must point to some concrete evidence in the record in support of those findings. *In re Zurko*, 258 F.3d 1371, 1386 (Fed. Cir. 2001).

With respect to the first factual inquiry, we argue that the Office has not properly established the scope and content of the prior art, so that the case for obviousness is incomplete

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and the rejection must be withdrawn. The rejected claims are directed to a rebar support chair, i.e., a chair for supporting and spacing concrete reinforcement members. We do not argue that the asserted primary reference is inappropriately cited. However, the asserted secondary reference is directed to a clamp for tubes and pipes. Moesta '029, col. 1 ll. 3-4. It is self-evident that rebar support chairs, which are used in reinforced concrete construction during the forming and pouring of concrete, and pipe clamps, which are used in pipe fitting during the installation of utilities, are devices used in distinctly different aspects of construction by distinctly different trades, so that the secondary reference is nonanalogous art. The burden lies with the Office to establish, and not to merely assume, that Moesta '029 is either within the field of the Applicants' endeavor or, if not, reasonably pertinent to the particular problem at hand. MPEP § 2141.01(a)(I). In the absence of such evidence, the alleged *prima facie* case for obviousness is incomplete and the rejection must be withdrawn.

With respect to the second factual inquiry, we argue that the Office has not properly ascertained the differences between the prior art and the rejected claims, so that the basis for the allegedly obvious modification is defective and the rejection must be withdrawn. Neither Hartzheim '949 nor Moesta '029 render the claimed invention, when viewed as a whole, obvious. Hartzheim '949 does not disclose, teach, or suggest a rebar support chair having the claimed bearing surface configuration. Moesta '029 discloses a pipe clamp that may include a flange portion 16 for gripping a flexible grommet 6, Moesta '029, col. 2 ll. 64-65, but does not teach or suggest that overall structure could be used for supporting rebar in a concrete form, or that identified substructure could be useful for supporting other structures in other applications. The mere fact that references can be combined or modified to produce a claimed invention does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01(III); *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Nothing in Hartzheim '949 or Moesta '029 suggests that the respective teachings should be combined to produce a rebar chair having the bearing surface recited in the rejected claims.

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The Office argues that a person of ordinary skill would incorporate a flange because Moesta '029 teaches and/or suggests that "it would provide more supporting surface for a tubular structure." However, having thoroughly reviewed the reference, we can find no disclosure supporting the alleged motivation to combine. Moesta '029 does not teach that flange 16 is included in the disclosed pipe clamp to provide support for a pipe or 'tubular structure.' Instead, the reference states that:

I prefer that flange portion 16 be provided on each semicircular edge portion 5 so that the flexible grommet 6 [positioned around a pipe 7] is gripped by the unitary member 2 toward the center portions but not necessarily at the center portion of the flexible grommet 6, and is gripped in the area between the support parts 4 but not at the center area between the support parts 4. The flexible grommet is thereby compressed at points toward the center of the flexible grommet 6 and toward the center area between the support parts 4, and a bulged portion 11 is formed at the center portion of the flexible grommet 6 in the center area between the support parts 4. By this arrangement, the grommet 6 is rigidly seated in the unitary member 2 and cannot slide out of the clamp apparatus...

This explicit teaching runs counter to the uncited teaching underlying the Office's rejection, and demonstrates that the rejection lacks a proper motivation to combine. *In re Lee*, 277 F.3d 1338, 1342-44 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references). The claimed rebar support chair does not include Moesta's top unitary member, does not serve as a clamp apparatus, and does not use a grommet to support and position rebar within the receiving area of the device. Since the claimed device lacks the structural elements cooperating with the cited flange element to provide the cited advantages, and does not, as claimed or typically used, seek to provide analogous features, a person of ordinary skill would not be motivated to modify a rebar support chair to incorporate such a flange on the basis of the Moesta reference. The Office

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does not cite to the alleged teaching of a flange-qua-tubular-support, and does not address the explicit, countervailing teaching of a flange-qua-grommet-lock. Thus the motivation to combine is presumptively found within the Applicant's specification rather than the prior art. Such a unsupported, hindsight-based rejection is barred by the Federal Circuit's decision in *In re Zurko* and countless other decisions pertaining to the obviousness inquiry. The alleged *prima facie* case for obviousness is therefore defective, and the rejection must be withdrawn.

*Rejection of claims 4 and 19 over Hartzheim '949 in view of Moesta '029 and Evans '422*

Claims 4 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hartzheim '949 in view of Moesta '029 and further in view of Evans '422. The Office admits that the modified device of Hartzheim '949 would not include pairs of notches being connected by a bridge therebetween, the bridge connecting the troughs of the notches. However, the Office alleges that Evans '422 discloses "a chair having notches connected by a bridge (46) therebetween, the bridge connecting the troughs of the notches," Office Action mailed 12/21/2006 at p. 3, and argues that it would have been obvious to further modify the device of Hartzheim '949 "because having bridges connecting troughs of notches would reinforce the notches against compression forces as taught by Evans," *id.* at p. 4.

We again argue that the Office has not properly established the scope and content of the prior art, so that the first factual inquiry is incomplete and the rejection must be withdrawn. The rejected claims are directed to a rebar support chair, and we do not argue that the asserted primary reference is inappropriately cited. However, the asserted secondary reference is directed to a clamp for tubes and pipes, Moesta '029, col. 1 ll. 3-4, and the asserted tertiary reference is similarly directed to a clamping member for hydraulic hoses, tubular conduits, or the like, Evans '422, Abstract. It is self-evident that rebar support chairs and the cited clamps are devices used in distinctly different arts. The burden lies with the Office to establish that both Moesta '029 and Evans '422 are within the field of the Applicants' endeavor or, if not, reasonably pertinent to the

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particular problem at hand. In the absence of such evidence, the alleged prima facie case for obviousness is incomplete, and the rejection must be withdrawn.

We also argue that the Office has not properly ascertained the differences between the prior art and the rejected claims, so that the basis for the allegedly obvious modification is defective and the rejection must be withdrawn. Neither Hartzheim '949 nor Moesta '029 nor Evans '422 render the claimed invention as a whole obvious. Hartzheim '949 does not disclose, teach, or suggest a rebar chair having a particular bearing surface configuration, e.g., where the bearing surface of each notch is defined by a lip extending inwardly from the outer surface such that the bearing surface is cantilevered beyond the inner surface, or a including a structure for reinforcing the receiving area of the chair, e.g., a bridge connecting the troughs of the notches. Moesta '029 discloses a pipe clamp that may include a flange portion 16 for gripping a flexible grommet 6, Moesta '029, col. 2 ll. 64-65, but does not teach or suggest that the identified substructure is useful for directly supporting other structures in other applications. Evans '422 discloses a clamping member for hydraulic hoses, conduits, and the like, but again does not teach or suggest that the identified substructure is useful for improving other types of devices in other applications. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Nothing in Hartzheim '949 and Moesta '029 and Evans '422 suggests that the respective teachings should be combined to produce a rebar support chair having the bearing surface and bridge configurations recited in the rejected claims.

We further argue that the alleged motivation to combine is inapplicable to the claimed invention. The Office argues that a person of ordinary skill would incorporate a bridge because Evans '422 teaches and/or suggests such bridges would reinforce against "compression forces," however, the proposed modification omits the opposing clamping member 10', bolts 12, and nuts 14 that generate such compression forces in the Evans device. Moreover, the reference reinforces the countervailing teachings in Moesta '029, in that Evans '422 also uses "sleeve

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members or grommets 18 of rubber or other elastomeric material" in a type of grommet lock. Evans '422, col. 2 ll. 18-20. The claimed rebar support chair does not include Evans' opposing clamping member, does not serve as a clamp apparatus, and does not use a grommet to support and position rebar within the receiving area of the device. Neither Moesta '029 nor Evans '422 teaches or suggests that overall structure could be used for supporting rebar in a concrete form, or that the identified substructures could be useful for supporting other structures in other applications. On the present record, the alleged *prima facie* case for obviousness lacks substantial evidence of a motivation to combine to produce the claimed invention, and the rejection must be withdrawn.

*Conclusion*

In view of the foregoing remarks, the Applicants respectfully submit that the claims are allowable over the art of record and pray for a prompt allowance. The Commissioner is authorized to charge any additional fees required or to credit any overpayment to Deposit Account No. 20-0809.

Respectfully submitted,

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